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In re Application of
ATKINSON (deceased)
Application No.: 10/583,215
PCT No.: PCT/AU2004/001766
Int. Filing Date: 16 December 2004
Priority Date: 18 December 2003
Atty. Docket No.: 04465/026001
For: HYBRID CONSTRUCTION
ELECTRIC MACHINE

DECISION

This is a decision on applicant's "RESPONSE TO NOTIFICATION OF DEFECTIVE RESPONSE" which filed in the U.S. Patent and Trademark Office (USPTO) on 02 October 2007, and the declaration of the inventor filed in the USPTO on 30 July 2007, which have been treated as a request for acceptance of the application under 37 CFR 1.42.

BACKGROUND

On 16 December 2004, applicant filed international application No. PCT/AU04/01766 which claimed a priority date of 18 December 2003, and which designated the United States.

The deadline for submission of a copy of the international application (unless previously communicated by the International Bureau) and payment of the basic national fee expired 30 months from the priority date, i.e. 18 June 2006.

On 16 June 2006, applicant filed a transmittal letter for entry into the national stage in the United States which was accompanied by, *inter alia*, the basic national fee and an unexecuted declaration of the inventor.

On 02 April 2007, the United States Designated/Elected Office (DO/EO/US) mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497 and a surcharge for providing the oath or declaration later than 30 months from the priority date were required.

On 30 July 2007, applicant filed, *inter alia*, a declaration executed by Daphne Atkinson and the requisite surcharge.

On 07 September 2007, the DO/EO/US mailed a NOTIFICATION OF DEFECTIVE RESPONSE (Form PCT/DO/EO/916) indicating that the declaration was not in compliance with 37 CFR 1.497 in that it identified and was executed someone other than the inventor named in the international application.

On 02 October 2007, applicant filed the present response which has been treated as a request that the application be accepted under 37 CFR 1.42 and 1.497(b)(2) as filed by Daphne Atkinson as the legal representative of inventor Donald Atkinson who is deceased.

DISCUSSION

A review of the application file reveals that the declaration by Daphne Atkinson as the legal representative of the deceased inventor, Donald Atkinson is not acceptable for the following reasons.

37 CFR 1.497(b)(2) states:

If the person making the oath or declaration or any supplemental oath or declaration is not the inventor (§§ 1.42, 1.43, or § 1.47), the oath or declaration shall state the relationship of the person to the inventor, and, upon information and belief, the facts which the inventor would have been required to state. If the person signing the oath or declaration is the legal representative of a deceased inventor, the oath or declaration shall also state that the person is a legal representative and the citizenship, residence and mailing address of the legal representative.

A review of the declaration filed 30 July 2007, reveals that it does not set forth the facts which the inventor would have been required to state. Specifically, the declaration provides the citizenship, residence and mailing address of the legal representative, but does not set forth such information for the actual inventor. Therefore, the application cannot be accepted under 37 CFR 1.42 at this time.

CONCLUSION

For the reasons above, the request under 37 CFR 1.42 is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Request Under 37 CFR 1.42". No additional petition fee is required.

A proper response must include a declaration of the inventors in compliance with 37 CFR 1.42 and 1.497.

Extensions of time may be obtained under 37 CFR 1.136(a).

Please direct further correspondence with respect to this matter to the Commissioner for Patents, Mail Stop PCT, PO Box 1450, Alexandria, VA 22313-1450, and address the contents of the letter to the attention of the Office of PCT Legal Administration.

A handwritten signature in black ink, appearing to read 'R. Cole', with a large, stylized loop at the end.

Richard R. Cole
PCT Legal Examiner
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